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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,482	04/04/2001	John C. Carson	A17-045	6243

7590

09/30/2002

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 09/30/2002

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*P. Gray  
9/29/02*

**Office Action Summary**

Application No.

09/826,482

Applicant(s)

CARSON ET AL.

Examiner

JYOTHSNA A VENKAT

Art Unit

1615

*File Copy*  
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 1-29 are pending in the application and the status of the application is as follows:

*In claim 8, " dipropylene glycol dibenzoate " is recited twice. Applicants are requested to delete 2<sup>nd</sup> occurrence of "dipropylene glycol dibenzoate ".*

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 10-12, 14-15 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

Clarification is requested for " alkyl and alkyl ether carboxylic acid salts " in claims 11 and 12.

Is the anionic surfactant alkyl carboxylic acid salt or alkyletheracid salt or is it a combination of both". If it is a combination of both, applicants are requested to provide the examiner the name of the surfactant.

Applicants are requested to correct " comprises" in claims 14 and 15. Applicants are also requested to correct " andr" in claim 26.

Clarification is requested for "monoesters of fatty acids and fatty alcohols containing a total of from 36-42 total carbon atoms " in claims 26. Is the oily material one component or is it a combination of both". If it is a combination of both, applicants are requested to provide the examiner the name of the oily material.

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Regarding claim 10, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4-5, 8-14, 16-21, 24-26 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowler et al. 5,635,469 ('469).

5. See col.13, lines 50-67 and col.14, lines 1-35 for anionic surfactant, which reads on the claimed surfactant solution, and specific surfactants of claims 11-12. See col.4, lines 35-65 and col.6-7 for the various cationic, amphoteric and non-ionic surfactants, which reads on the claim 13. See col.10, lines 65-67 for the claimed penetration enhancers. See col.15-16 for sunscreen actives. See the ingredients octyl salicylate and octocrylene which reads on the claimed "*high density emollient/conditioning layer comprising at least one high density aromatic ester emollient or conditioning agent having a specific gravity of greater than one*" and also reads on claims 8-9 and 24-25. See col.11, for "*jojoba oil*" which reads on the claimed "emollient/conditioning agent". Since all the components are the same, the mixing of these ingredients will result in the specific gravity claimed and the layers claimed (inherent property) absence of evidence to the contrary. Since the components are the same the claims 16-17 are inherent. See the abstract for the personal cleansing product and see the examples.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3,7 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent '469 and U. S. Patent 6,294,509('509)

The instant application is claiming multi-phase surfactant compositions comprising:

- a. High density aromatic ester emollient or conditioning agent
- b. surfactant solution
- c. Low density oil
- d. Penetration enhancer
- e. Exfoliating agent.

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The patent '569 discloses ingredients a-d. See the relevant portions outlined above. The patent does not disclose ingredient (e). However the patent '509 discloses (e) in detergent cosmetic compositions. See the abstract and see col.3, line 7 for particles of polyethylene. Applicants are claiming the same "*polyethylene particles*" in claim 7. See also line 14 for bentonite, and lines 30-31 for seaweeds. Applicants are claiming, "*ground plant material*". The compositions also use surfactant in col.5; lines 52-65. These particles are used in the same field of endeavor.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made, to prepare cleansing products of patent '469 and add the disintegrating particles of '509 expecting beneficial effect to the skin. The idea of ingredient flows logically from the art for having been used in the same field, which are cosmetic cleansing products. Motivation to use the particles stems from the teachings of '509, that the particles has outstanding physical (mechanical) cleaning capability, and has excellent rinsability properties because the particles readily disintegrate during rinsing. This is a *prima facie* case of obviousness.

9. Claims 8-9 and 22-23 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent '469 and U. S. Patent 5,959,130('130).

The instant application is claiming multi-phase surfactant compositions comprising:

- a. High density aromatic ester emollient or conditioning agent
- b. Surfactant solution
- c. Low density oil
- d. Penetration enhancer

e. Exfoliating agent.

10. The patent '569 discloses ingredients a-d. See the relevant portions outlined above. The patent does not disclose the specific aromatic esters, which are claimed in claims 22-23.

However the patent '130 discloses the specific aromatic ester emollient, which is “*dipropylene glycoldibenzoate*”. See the abstract, see col.7, lines 20-30 for the applicability of the esters and see col.17, table III for Finsolv, which is the same compound, claimed in the instant application.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made, to prepare cleansing products of patent'469 and add the specific aromatic ester emollient which is “*dipropylene glycoldibenzoate*” expecting beneficial effect to the skin. The idea of ingredient flows logically from the art for having been used in the same field, which is the cosmetic field. Motivation to use the “*dipropylene glycoldibenzoate*” stems from the teachings of '130 that the benzoate esters have unexpected properties, and these ester are useful as vehicles or carriers, emollients or solubilizers for hair and skin care formulations. The patent also teaches that when these esters are applied to the skin they soften and soothe the skin and cosmetically affect the skin, such as by cleansing, reducing or enhancing the odor, sun blocking. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on M-F, 9:30-6:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for



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the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



JYOTHSNA A VENKAT

Primary Examiner

Art Unit 1615

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August 9, 2002